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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER

QM32/0217

SHAY, D

ART UNIT

PAPER NUMBER

3739

DATE MAILED:

02/17/00

THOMAS B HAVERSTOCK  
HAVERSTOCK & OWENS  
260 SHERIDAN AVENUE  
SUITE 420  
PALO ALTO CA 94306

Please find below and/or attached an Office communication concerning this application or proceeding.

**Commissioner of Patents and Trademarks**

## Office Action Summary

Application No.

09/048,104

Applicant(s)

Holbart

Examiner

d. shay

Group Art Unit

3739

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

### Status

Responsive to communication(s) filed on November 12, 1999

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

Claim(s) 1-40 is/are pending in the application.

Of the above claim(s) 15, 16 & 25-40 is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 1-14, & 17-24 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119 (a)-(d)

Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

### Attachment(s)

Information Disclosure Statement(s), PTO-1449, Paper No(s). 5  Interview Summary, PTO-413

Notice of Reference(s) Cited, PTO-892  Notice of Informal Patent Application, PTO-152

Notice of Draftsperson's Patent Drawing Review, PTO-948  Other \_\_\_\_\_

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Claims 13, 16 and 25-40 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to a non-elected invention. Election was made **without** traverse in Paper No. 7.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 exactly what is to be encompassed by the term "laser delivery apparatus" in view of the recitation in claim 2 and the extent that claim 2 limits claim 1, claim 1 is incomplete. Claim 2 is indefinite as it fails to further limit claim 1. In claim 11 there is no antecedent basis in the originally filed specification for generating a coagulation depth in response to an ablative pulse.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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Claims 1, 2, 8 and 11 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Kung et al.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 6-8, 11-14, and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sklar et al in combination with Dew ('969), Belkin et al and Anderson et al.. Sklar et al teach a laser system with a graphical interface and teach that it can be used for any type of surgery and with any type of laser and that the depth of the laser action can be input and displayed. Dew (969) teaches the use of a carbon dioxide laser as a cutting laser and teaches that the power of a pulse determines the amount of heat deposited in the tissue, Balkin et al teaches that carbon dioxide lasers can be used to heat, rather than cut tissue. Anderson teach the way parameters such as absorptivevity, <sup>spot</sup> size, and pulse width interrelate to control the amount <sup>down</sup> of energy absorbed by tissue. It would have been obvious to the artisan of ordinary skill to use a carbon dioxide laser as taught by Dew ('966) in the graphical user interface of Sklar et al, since this is to be used with any laser, as taught by Sklar et al, to also configure the laser to coagulate as taught by Belkin et al, since this would render the device more versital, at no extra cost, and is within the scope of one having ordinary skill in the art to shown by Anderson et al, and employ

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an articulated arm with refocussing optics, since these are notorious in the art for transporting infrared radiation such as that from Carbon dioxide lasers, official notice of which is hereby taken, thus producing a device such as claimed.

Claims 4, 5, 9, 10, and 20-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sklar et al in combination with Dew ('969), Anderson et al and Belkin et al as applied to claims 3, 6-8, 12-14 and 17-19 above, and further in view of Assa et al..

Assa et al teach a scanning handpiece and the equivalence of carbon dioxide and Erbium YAG lasers. Thus it would have been obvious to the artisan of ordinary skill to employ a handpiece as taught by Assa et al, since this allows more consistency of treatment and to employ an erbium laser, since these are equivalent to the carbon dioxide laser, thus producing a device such as claimed.

Any inquiry concerning this communication should be directed to David Shay at telephone number (703) 308-2215.

David Shay:bhw  
February 4, 2000



DAVID M. SHAY  
PRIMARY EXAMINER  
GROUP 330